

REMARKS

This paper is responsive to an Office Action dated March 16, 2004. Prior to this response, claims 1-35 were pending. After amending claims 1-2, 8, 12, 16, 19, 23, 25, 29, and 33, and canceling claims 9 and 26, claims 1-8, 10-25, and 27-35 remain pending.

Section 2 of the Office Action states that claims 1-35 have been rejected under 35 U.S.C. 102(e) as anticipated by Mazzagatte et al. ("Mazzagatte"; US Patent 6,862,583). With respect to claims 1, 12, 19, and 29, the Office Action states that Mazzagatte describes the claim elements of encrypting documents with a public key, transmitting encrypted documents to a printer, accepting a private key at the printer, decrypting the documents, and printing. This rejection is traversed as follows.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Generally (as seen in Fig. 5), Mazzagatte describes a process that transmits an unencrypted document using a secure protocol, such as SSL, to a printer, along with a form of identification. At the printer, the document is encrypted and stored. Figs. 6, 7A, and 7B describe the operations performed at a printer. To print a document, the user presents identification to the printer. Then, the printer decrypts the document and prints it.

Mazzagatte's process is different than the claimed invention. The Office Action states that Mazzagatte includes the step of "encrypting documents with a public key" (col. 8, ln. 14 and 39). As mentioned above, Mazzagatte describes a detailed process that transmits unencrypted documents. In one line only, line 14 of col. 8, he states that the print job may be encrypted before transmission. However, Mazzagatte does not mention the encryption means. That is, Mazzagatte does not discuss using a public key to encrypt the print job.

Line 39 of col. 8 discusses Mazzagatte's preferred embodiment, where the print job is encrypted *after* being received by a printer. Mazzagatte states that the printer may be equipped with a smart card reader, and that a private key loaded on a smart card may be used for identification purposes (col. 8, ln. 34-43).

To further clarify the differences between Mazzagatte and the claimed invention, claims 1, 12, 19, and 29, the claims have been amended to recite the feature of storing the encrypted documents on a file server, before the user initiates the decryption process at the printer. As a result, printer memories can be made significantly smaller, as the encrypted documents are not stored on the printer.

In summary, Mazzagatte fails to describe several elements of the claimed invention as amended. With respect to claims 1 and 12, Mazzagatte fails to describe the step of transmitting documents to a printer that have been encrypted with a public key. With respect to claims 19 and 29, Mazzagatte fails to describe a computer that encrypts documents using a public key, or a printer that accepts public-key encrypted documents. Neither does Mazzagatte describe a system that stores the encrypted documents on a file server, prior to decryption.

The analysis above proves that Mazzagatte does not explicitly describe every element of the claimed invention. Since Mazzagatte does not explicitly describe every element of claims 1, 12, 19, and 29, he cannot anticipate those claims. Claims 2-8 and 10-11, dependent from claim 1, claims 13-18, dependent from claim 12, claims 20-25 and 27-28, dependent from claim 19, and claims 30-35, dependent from claim 29, enjoy all the above-mentioned distinctions from the cited prior art, and the Applicant respectfully requests that the rejection be removed.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Date: 4/14/05

Respectfully submitted,


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